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EXAMINER

VORTMAN, ANATOLY

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2835

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/575,776
Filing Date: May 22, 2000
Appellant(s): HENRY, CHERYL

MAILED
JUL 02 2003
GROUP 2800

Peter Forrest, Reg. No. 33,235
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on May 07, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

Contrary to the Appellant's position that "issues addressed by that amendments do not impact [sic] the Examiner's position", the Examiner believes that proposed amendments have been made in light of the "Response to Arguments" section of the Final Office Action mailed on 11/08/02 (paper # 14), and if entered, would change the scope of the claims. The Applicant has narrowed the claims to recite that "a processor programmed to read and communicate only the FILE DIRECTORY (emphasis added) information" instead of generic and broad "file information" as recited in the original claims. Therefore, the amendment after final rejection filed on 05/07/03 has not been entered.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because of the following: the Appellant's position is that "The file reading apparatus 10, as *defined by the claims* (emphasis added) on appeal, uses a programmed processor (not shown) to ensure that the apparatus may read and communicate only the file directory information to the display screen 16 or (in some embodiments) a printer" (page 2, last four lines).

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On the contrary, the claims on appeal do not provide any substance as to insure that said processor is specifically programmed in order for the apparatus to read and communicate only the file directory information. Claims on appeal recite only the broad statement that “the processor is programmed to read and communicate only *the file information* (emphasis added)”.

(6) Issues

The Appellant’s statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that the following four groups of claims: 1-5, 6-8, 10-12, and 13-22 do not stand or fall together, but does not provide reasons for that as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims 1-8 and 10-22 (Prior to Entry of Accompanying Amendments) contained in the Appendix to the brief (p. 9-11) is correct.

(9) Prior Art of Record

5,566,290

Silverbrook

10-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over US/5,566,290 to Silverbrook.

Regarding claims 1 and 6, Silverbrook disclosed (Fig. 1 and 2) a portable apparatus (1) for reading only file directory information stored on a separately portable self contained data storage device (11), the portable apparatus not in communication with a personal computer, the apparatus comprising:

a handheld housing (2, 9) (the housing may be held in hands if so desired);

a drive component (79) for reading the file directory information on the data storage device (11), (column 2, lines 4+);

a loading mechanism (79) for receiving the data storage device (11) and retaining the data storage device such that the drive component (79) reads the file directory information on command (column 2, lines 4+);

a processor (70) programmed to read and communicate only file information (please, note, that any computer data, including video information is contained in files. Thus, said

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processor (70), inherently reads and communicates only a file (image file) information (column 2, lines 64+; column 3, lines 65+; column 4, lines 1+)); and,

a visual display (4) operably connected to the drive component through the processor (70) for viewing the file information contained on the data storage device (11), but did not explicitly stated that said file information is only the file directory information.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to view any desirable information on said visual display, including only the file directory information, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 6 and 16, Silverbrook further disclosed a printer (an output device) operably connected to the drive component to print the file directory contents contained on the display (4), (column 3, lines 45+).

Regarding claims 13 and 14, Silverbrook disclosed at least one data storage drive (79 or 78) for reading the file directory information from at least one respective type of data storage device (11 or 21); and a visual display output device (4) for providing the file directory information contained on the data storage device (11 or 21).

Regarding claim 2, Silverbrook disclosed a printer (column 3, lines 45+) to print the file directory information retrieved from the data storage device (11) by the drive component (79).

Regarding claims 3 and 15, Silverbrook disclosed that the visual display (4) is a liquid crystal display (column 1, line 66).

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Regarding claims 4 and 19, Silverbrook disclosed that the drive component reads magnetic storage media (21), (column 2, lines 26+).

Regarding claims 5 and 20, Silverbrook disclosed that the drive component reads optical storage media (column 2, lines 4+).

Regarding claims 8 and 18, Silverbrook disclosed that the printer is an attachable unit (column 3, lines 45+).

Regarding claims 10-12, the method steps recited in the claims are inherently necessitated by the device structure as disclosed by Silverbrook.

Regarding claims 9, 21 and 22, Silverbrook disclosed two drive (a plurality) components (78 and 79) on of which is a magnetic storage drive (78) and another is an optical storage drive (79).

Regarding claims 7 and 17, Silverbrook disclosed all of the claim's limitations as apply to claims 6 and 16 respectively, but did not disclose that the printer is located within the housing of the apparatus.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate said printer within the apparatus housing in order to enhance the versatility of the device, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

(11) Response to Argument

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The Examiner would like to direct the Honorable Board's attention to the fact that the Appellant's interpretation of the rejection (in view of Silverbrook ('290) reference) is erroneous regarding the Examiner's admissions (p. 4 and 5 of the Brief). As stated in the rejection, all of the limitations recited on p. 4 and 5 of the Brief have been met by Silverbrook ('290), but Silverbrook "did not explicitly stated that said file information is only (emphasis added) the file directory information" (Final Office Action (paper No. 14), p. 3, lines 6 and 7).

The Examiner would like to reiterate that device of Silverbrook ('290) is capable of reading, viewing or printing any file information including the file directory information (i.e. directory of the audio or video files). What Silverbrook did not disclose, is that the device is for processing the only file directory information.

Regarding the Appellant's discussion involving *In re Alappat*, (p. 6 of the Brief) the Examiner agrees that a processor-based invention may be claimed in terms that use both hardware and software. But claims of the instant application do not recite any software in support for the specific function (i.e. processing only the file directory information). Regarding the processor which is a main computer component, the claims only broadly state that the processor programmed to read and communicate only file information, which any computer processor is designed to do, since all computer data, including video and audio information is contained in files. Thus, claims are silent regarding the specific way the processor is programmed in order to process only file directory information. Therefore, the Examiner believes that *In re Alappat* is not applicable in the instant case, since there is no combination of software and hardware or any programming have been presented in the claims of the instant application. The Examiner believes that apparatus as recited in the claims of the instant application is a general purpose

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computer which is used (by a user) for viewing of the only file directory information, a task which is perfectly suitable for the device of Silverbrook ('290).

Furthermore, the Appellant contends that the preamble to the claim explicitly puts life and meaning into the claim by reciting: "a portable apparatus for reading only file directory information" (p. 6, lines 17+ of the Brief).

The Examiner believes that preamble does not put any life or meaning into the claims of the instant application, since as it has been stated earlier, claims of the instant application do not contain any specific combinations of software and hardware for the purpose of performing the specific function. The preamble recites mere the way of using the device, i.e. the way of using a general-purpose computer for reading only the file directory information.

It was settled that a statement of intended use or purpose (in a preamble) usually will not limit the scope of the claim since such statements merely define the context in which the invention operates. *DeGeorge v. Bernier*, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985).

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim did not distinguish over the prior art apparatus).

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In the instant case, intended use (processing only the file directory information) does not result in a structural difference between the claimed invention and the Silverbrook ('290) apparatus.

If a prior art structure is capable of performing the intended use as recited in the preamble, than it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir.1997). Indeed, the Silverbrook ('290) device is perfectly capable of processing only the file directory information as required by the preambles of the claims on appeal.

Furthermore, the Appellant contends that "when claim as a whole is considered, that it contains structural limitations that limit the use of the claimed apparatus to displaying only file directory information", (p.6, lines 19+). In response the Examiner would like to reiterate that no structural limitations have been recited in the claims that would limit the claimed apparatus to process only the file directory information. Only the functional recitations pertained to the intended use of the general-purpose computer have been presented. Also nothing specific regarding the programming of the processor have been presented in the claims.

The Examiner believes that structurally, the claimed device and the device disclosed by Silverbrook ('290) are identical. The main distinction between the claimed device and the Silverbrook's is not in the structure, as erroneously asserted by the Appellant (p. 7, lines 8+ of the Brief), but in a specific way the device of the present invention is intended to be employed. Only the difference involving the intended use of the device has been admitted by the Examiner in the outstanding rejection. Therefore, in light of the preceding discussion, the Examiner believes that *In re Alappat* is not applicable to the present invention as claimed (no software or

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programming limitations pertained to the processor are present) and the 35 USC 103 rejection is appropriate.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Anatoly Vortman
Primary Examiner
Art Unit 2835

A.V.
June 26, 2003



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